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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,712	07/23/2007	Tim Gamble	713-1282	3179
33712	7590	03/27/2009		
LOWE, HAUPTMAN, HAM & BERNER, LLP (ITW) 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314			EXAMINER	
			NASH, BRIAN D	
		ART UNIT	PAPER NUMBER	
		3721		
		MAIL DATE	DELIVERY MODE	
		03/27/2009	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/599,712	GAMBLE ET AL.
	<b>Examiner</b>	Art Unit
	Brian Nash	3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 19 February 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-23 is/are pending in the application.  
 4a) Of the above claim(s) 20-23 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 October 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/1449)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Examiner's Comments***

1. This action is in response to applicant's election received 2/19/2009.
2. Applicant elected Group I, claims 1-19 drawn to an adaptor for a fastener tool having a mounting bracket for attachment thereto with traverse. The traversal is on the ground(s) that examining both groups would not place a serious burden on the Examiner. This is not found persuasive because the inventions are distinct for the reasons set forth in the prior office action. The requirement is still deemed proper and is therefore made FINAL.
3. The pending claims remain 1-23; however, claims 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.
4. The Examiner notes that the office action below may reference support found in the cited prior art by indicating element numbers, figures or by pointing out a specific paragraph (PAR) number in which support can be found. The PAR number referenced corresponds to paragraph number beginning in the "Detailed Description" of the disclosure unless otherwise noted.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claim 12 does not further limit the structure of the claimed invention. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-9 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by US 3,998,372 to Leonardo et al.

With respect to claims 1 and 12, an adaptor (16) for a tool (10), having an attachment portion (18) for coupling to the tool and a support (40,44) arranged to hold a mounting bracket relative to a substrate and allow a fastener from the tool to be driven through the mounting bracket (figs. 3,4, PARs 1-6).

With respect to claim 2, that attachment portion is fitted to a nosepiece of the tool (via 22,24, fig. 5).

With respect to claim 3, the attachment portion includes an aperture (18) which receives the nosepiece of the tool (fig. 4, PAR 3).

With respect to claims 4-5, the adaptor is provided with a lock (22,24 via 26, PAR 4, figs. 2,5) for releasably locking the adaptor to the nosepiece of the tool. The lock is operable via an annular groove (22) formed on the nosepiece.

With respect to claim 6, the adaptor is arranged to align and aperture of the mounting bracket with a nosepiece (14) of the tool.

With respect to claims 7-9, the adaptor has a plurality of supports (supports 40,42) located on the adaptor are adjustable so as to provide a support surface for a plurality of differently-sized brackets.

With respect to claim 13, the support tabs (42,44) hold a bracket in place against a substrate to assist a user in aligning the bracket and substrate correctly.

Art Unit: 3721

9. Claims 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,484,094 to Gupta.

With respect to claim 14, a holder (40) for holding an item (20) to facilitate attachment of the item to a substrate by a fastener (12) wherein the holder magnetically (via 90) retains the item in a position to receive the fastener from a tool (10).

With respect to claims 15-16, the holder (40,70) is adapted to be mounted on a nosepiece (14) of a tool and includes a structure to engage the nosepiece.

With respect to claim 17, the structure has an aperture which receives the nosepiece (fig. 4, undesignated aperture).

With respect to claim 18, the holder is provided with a lock (50, PAR 8) for releasably locking the holder to the nosepiece.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,998,372 to Leonardo et al. As discussed above, Leonardo discloses the invention substantially as claimed showing an adaptor (16) for a tool (10), having an attachment portion (18) for coupling to the tool and supports (40,44, fig.3) arranged to hold a mounting bracket. The supports extend outwardly from opposite sides of the adaptor body; however the supports are not in the form of a curved arm, but rather square-shaped clamping arms (fig. 3). It would have been an obvious matter of design choice to modify the shape of the clamping arms since applicant has not disclosed that the shape of the arms solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either design choice.

Art Unit: 3721

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 3,998,372 to Leonardo et al in view of US 5,484,094 to Gupta. As discussed above, Leonardo discloses the invention substantially as claimed showing an adaptor (16) for a tool (10), having an attachment portion (18) for coupling to the tool and supports (40,44, fig.3) arranged to hold a mounting bracket. Leonardo does not disclose the use of a magnetic member for holding a mounting bracket in place prior to it being fastened to a substrate. However, Gupta does show a holder having a magnetic means (90) for retaining an item in a position to receive the fastener from a tool. Gupta teaches the well known and expected use of a magnetic means in place of a clamping means, if desired, and it would have been obvious to one skilled in the art to configure/modify the fastening tool of Leonardo in order to utilize the desired retaining means, since such a modification is within the engineering purview of the skilled artisan.

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,484,094 to Gupta in view of US 3,998,372 to Leonardo et al. As discussed above, Gupta discloses the invention substantially as claimed showing a holder (40) for holding an item (20) to facilitate attachment of the item to a substrate by a fastener (12) wherein the holder is provided with a lock (50, PAR 8) for releasably locking the holder to the nosepiece. As shown (fig. 4), Gupta discloses a lock that is selectively operable to engage with grooves formed on an outer surface of the nosepiece. Leonardo shows an adaptor provided with a lock (22,24 via 26, PAR 4, figs. 2,5) for releasably locking the adaptor to the nosepiece of the tool. The lock is operable via an annular groove (22) formed on the nosepiece. In view of Leonardo, it would have been an obvious matter of design choice for the locking grooves to be on an annular surface since applicant has not disclosed that the surface on which the grooves are located solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with either design choice.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment (PTO-892) for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Friday from 8 a.m. to 4 p.m.
16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300
17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more information about the PAIR system, see [www.uspto.gov](http://www.uspto.gov). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Brian D. Nash/  
Primary Examiner, Art Unit 3721

3/24/2009